

**REMARKS**

Applicants have canceled instrument claims 6-11 and 13-15 without prejudice to expedite prosecution of the prosthesis claims remaining in this application. Applicants have also amended independent claim 1 and added new independent claim 16 along with dependent claims 17-20 corresponding to claims 3-5 and 12. Amended claim 1 finds support at page 8, lines 14-21, of the specification; new claim 16 finds support at page 8, lines 21-28, of the specification, which defines the term "edge tangent" as used in new claim 16 with respect to Fig. 7 of the drawings as being "a tangent which, in sagittal section, is located at a point 17 which is not more than 4 mm away from the edge 18 of the upper cover plate 11." The broadest reasonable interpretation of the term "edge tangent" is this definition in the specification. The invention of amended claim 1 has the advantage of being locked by its shape to the contacting bone surface and cannot easily escape from its position, unlike a spherical shape, which is prone to slide along its spherical contour. The invention of claim 16 allows the retention by the surgeon of more of the edge regions of the bone against which the prosthesis is to be implanted than is the case with differently shaped upper cover plates. Entry of these amendments is respectfully requested.

Claims 1-5 and 12 stand rejected under 35 USC 103(a) on the combination of Bryan '400 in view of Kuntz. The Examiner recognizes that Bryan '400 falls short of the invention of original claim 1 at least with respect to the flat surface of the lower cover plate and the shape as claimed on the upper cover plate, referring to Kuntz for a disclosure of these features. Kuntz does not disclose or suggest the features of either amended claim 1 or new claim 16, so these claims could not have been obvious over Bryan '400 in view of Kuntz. Neither Kuntz nor any other reference of record discloses the conical top face of the upper cover plate or the advantages achieved by such a conical top face, so claim 1 is patentable. Likewise, the prior art fails to disclose or suggest the edge tangents as defined in claim 16 that enclose an angle with respect to one another that is not greater than 90° or any reason to employ such a configuration..

Claims 1-5 and 12 also stand rejected under 35 USC 103(a) on Bryan '400 in view of Hamada, which is applied in the same way as the Examiner applied Kuntz. Hamada does not

disclose the features of claims 1 or 16 as discussed above with respect to Kuntz, so the combination of Bryan '400 and Hamada could not have made the inventions of those claims obvious.

With respect to claims 2 and 5 (and thus new claim 19 as well) the Examiner argues that it would have been obvious to have provided the upper cover plate with the claimed shapes "since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art." The problem with this logic is that it assumes what it must prove, that persons of ordinary skill in the art would have been motivated to arrive at the inventions of these claims based on their subject matter as a whole. With due respect to the Examiner, there is no evidence in this record that the limitations of claims 2, 5 and 19 it would allegedly have been routine to modify were in fact considered to be result effective by those of ordinary skill in the art in the context of the inventions of these claims as they now stand. Furthermore, claims 5 and 19 do not appear to recite "values" that would be optimizable.

The remaining rejections are moot in view of the cancellation of instrument claims 6-11 and 13-15.

Early action allowing claims 1-5, 12 and 16-20 is solicited.

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Respectfully submitted,

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By:   
Barry E. Bretschneider  
Registration No. 28,055

Morrison & Foerster LLP  
1650 Tysons Boulevard  
Suite 300  
McLean, Virginia 22102  
Telephone: (703) 760-7743  
Facsimile: (703) 760-7777